

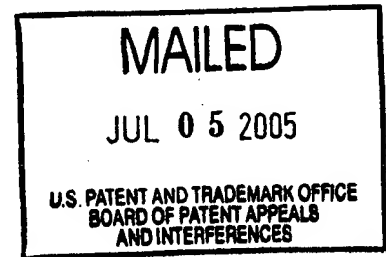
UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte CURTIS OHRT

Appeal No. 2005-0101
Application No. 09/504,978

ON BRIEF



Before JERRY SMITH, BARRY, and SAADAT, *Administrative Patent Judges*.
BARRY, *Administrative Patent Judge*.

A patent examiner rejected claims 1-23. The appellant appeals therefrom under 35 U.S.C. § 134(a). We remand.

In an *ex parte* appeal, "the Board is basically a board of review — we review . . . rejections made by patent examiners." *Ex parte Gambogi*, 62 USPQ2d 1209, 1211 (Bd.Pat.App. & Int. 2001). Here, after considering the record, we are persuaded that "[t]he appeal is manifestly not ready for a decision on the merits." *Ex parte Braeken*, 54 USPQ2d 1110, 1112 (Bd.Pat.App. & Int. 1999). Our opinion addresses the following reasons for remanding:

- status of indefiniteness rejection
- completeness of summary of invention.

I. STATUS OF INDEFINITENESS REJECTION

"For each ground of rejection applicable to the appealed claims," M.P.E.P. § 1208 (8th ed., rev. 1, Feb. 2003), an examiner's answer shall include "an explanation of the ground of rejection. . . ." *Id.* Here, the *Grounds of Rejection* section of the examiner's answer, (Examiner's Answer at 4-14), omits any mention of a rejection of the pending claims for indefiniteness under 35 U.S.C. § 112, ¶ 2. The *Response to Argument* section of the answer, however, includes replies "to [a]ppellant's assertion that claims 1-15 are not properly rejected under 35 USC § 112," (*id.* at 14), and "to [a]ppellant's assertion that claims 16-23 are not properly rejected under 35 USC § 112. . . ." (*id.* at 15.)

The omission of the rejection in the former section *vis-à-vis* the mention of the rejection in the latter section leaves us uncertain whether the examiner intends to reject the claims for indefiniteness. We "decline to substitute speculation as to the rejection for the greater certainty which should come from the [examiner] in a more definite [explanation] of the grounds of rejections." *Gambogi*, 62 USPQ2d at 1212. Instead, we need the examiner to clarify the status of the indefiniteness rejection in a substitute examiner's answer. More specifically, if he intends to reject claims as indefinite, he should state and explain such a rejection in the *Grounds of Rejection* section of the

substitute answer. If he intends to omit such a rejection, however, he should omit any mention thereof in the *Response to Argument* section thereof.

II. COMPLETENESS OF SUMMARY OF INVENTION

An appeal brief shall contain a *Summary of Invention* section. "[I]t is preferable to read the appealed claims on the specification and any drawing." M.P.E.P. § 1206. "[R]eference to page and line number of the specification . . . is considered important to enable the Board to more quickly determine where the claimed subject matter is described in the application." *Id.*

Here, the *Summary of Invention* section of the appellant's brief does not read the claims on the specification or drawings. We ask the appellant to prepare a substitute brief that reads each of the independent claims (viz., claims 1 and 16), and any dependent claims argued separately, on their specification and drawings. In particular, a mapping of each of the claimed limitations to specific pages and lines of the specification and reference characters of the drawings is requested for a meaningful review.

III. CONCLUSION

For the aforementioned reasons, the application is remanded to the examiner for further action not inconsistent with the views expressed herein. Any subsequent answer submitted by the examiner should be self-contained with respect to all rejections and arguments. No prior answer should be referenced or incorporated therein. Similarly, any subsequent brief submitted by the appellant should be self-contained with respect to all arguments. No prior brief should be referenced or incorporated therein.

Because it is being remanded for further action, the application is a "special" application. M.P.E.P. § 708.01(D). Accordingly, it requires immediate action. Furthermore, the Board should be informed promptly of any action affecting status of the appeal (e.g., abandonment, issue, reopening prosecution).

Jerry Smith
JERRY SMITH


LANCE LEONARD BARRY
Administrative Patent Judge

Mahshid D. Dadgar

MAHSHID D. SAADAT
Administrative Patent Judge

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